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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,569	11/14/2003	Wolfgang Altmeyer	ALTMAYER-6	1784
20151	7590	12/01/2004	EXAMINER	
HENRY M FEIEREISEN, LLC 350 FIFTH AVENUE SUITE 4714 NEW YORK, NY 10118			FORD, ALLISON M	
			ART UNIT	PAPER NUMBER
			1651	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,569

Applicant(s)

ALTMAYER ET AL.

Examiner

Allison M Ford

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention: a method for the determination of genus, species, breed, and/or geographical origin of biological materials, comprising converting the biological materials by a chemical or bio-catalytic conversion into cleavage peptides; detecting the cleavage peptides by mass spectrometry; and comparing analyses.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Currently, claim 1 is generic to:

- the type of chemical or bio-catalytic conversion, including those found in claim 2 (disulfide bond cleavage by reducing or oxidizing agents), claim 4 (chemical hydrolysis of bio-polymers), and claim 5 (hydrolytic cleavage by hydrolytic cleavage enzymes)

Contingent with election of a reaction, an election of the appropriate reagents must also be made:

- o upon election of disulfide bond cleavage (claim 2):
 - thiols, sulfides, sulfoxides, sulfones, sulfonamides, peroxides, metal catalysts, phosphines, phosphites, phosphates, halogenes, oxiranes, alkynes, olefines, amides, amines, carbon acids, carbon acid esters, alcohol, aldehydes, and ketones (found in claim 3)
- o upon election of hydrolytic cleavage by hydrolytic enzymes (claim 5):
 - trypsin, chymotrypsin, endoproteinase Glu-C (V8-protease), endoproteinase Lys-C, endoproteinase Arg-C, endoproteinase Asp-N, thrombin, papain, pepsin, plasmin and mixtures of such enzymes (found in claim 6)

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- type of biological catalyst, including bacteria, fungi, plant cells, animal cells, human cells or tissue and combinations thereof, enzymes, antibodies, proteins, ribo-enzymes, and peptides

Additionally, claim 8 is generic to a plurality of specific detection systems, including atmospheric pressure chemical ionisation (APCI), chemical ionisation (CI), election ionisation (EI), electrospray ionisation (ES), fast atom bombardment (FAB), field desorption (DF), field ionisation (FI) laser induced liquid beam ionisation desorption (LILBID), liquid secondary ion mass spectrometry (LSIMS), matrix assisted laser desorption ionisation (MALDI), particle beam (PB), plasma desorption (PD), secondary ion mass spectrometry (SIMS), thermospray (TSP) or a combination of such ionisation methods (found in claim 9)

Finally, claim 10 is generic to a plurality of liquid chromatography methods, including liquid chromatography, middle pressure liquid chromatography, and high performance liquid chromatography (found in claim 11).

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an

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allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

An election must be made in replying to this Office action. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allison M Ford whose telephone number is 571-272-2936. The examiner can normally be reached on M-F 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0927. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Allison M Ford
Examiner
Art Unit 1651



LEON B. LANKFORD, JR.
PRIMARY EXAMINER